



United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,250	12/04/2001	Steve Lee	LSI-108	5052

7590 11/06/2003

Kevin D. Erickson
Paulcy Petersen Kinne & Fejer
Suite 365
2800 West Higgins Road
Hoffman Estates, IL 60195

EXAMINER

TSIDULKO, MARK

ART UNIT	PAPER NUMBER
----------	--------------

2875

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1-11** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,247,829 of Lee in view of Henning et al. (U.S. 4,598,229) and Hilderman (U.S. 5,030,100).

<i>Instant Application</i>	<i>Patent ('829)</i>	<i>Differences</i>
1, 4, 5, 9, 10, 11	15	<p>The scope of claims 1, 4, 5, 10 of the instant application is incorporated in the patented claim 15.</p> <p>Referring to Claim 9 it is well known in the art and technology that the thickness of the inner surface of the light is thin enough to be invisible from the outside of the bulb.</p> <p>Referring to claim 11 a bulbs made of colored</p>

		translucent glass are well known in the art. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to provide the the decorative bulb wherein the outer surface and a plurality of contoured continents are formed of a translucent colored glass.
2	10	The scope of claim 2 of the instant application is incorporated in the patented claim 10.
3	9	The scope of claim 3 of the instant application is incorporated in the patented claim 9.
6-8	9	The scope of claim 6-8 of the instant application is incorporated in the patented claim 9. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, that the decorative bulb may have any desired shape for purpose of aesthetical appearance.

Referring to Claims **1, 4, 5** Lee discloses the instant claimed invention except for:

- a surface feature formed on an outer surface of bulb and having an inner surface;

- a coating applied on the inner surface of the surface feature for the second color along an inner surface of the surface feature.

Hilderman discloses (Fig. 4, col.5, lines 26-39) a lighted globe having spherical body and a surface feature [26] mounted on an outer surface of spherical body. The surface feature has an inner surface and outer surface, which provides an enhanced appearance of the earth's surface showing a plurality of contoured continents.

Henning et al. disclose a lamp having a coating (col.1, lines 36-38) on an inner surface.

It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to provide the coating of Henning et al. on the inner surface of the surface feature of Hilderman for decorative light bulb of Lee in order to obtain the colored ethereal electrical arcing along the inner surface of surface feature.

Referring to Claim **10** Lee discloses the instant claimed invention except for:

- bulb has outer surface forming a globe;
- a plurality of contoured continents having an inner surface and formed on the outer surface of the bulb;
- a phosphor coating applied on the inner surface of the contoured continents and resulting in electrical arcing having a green color.

Hilderman discloses (Fig. 4, col.5, lines 26-39) a lighted globe having spherical body and a surface feature [26] mounted on an outer surface of spherical body. The surface feature has an inner surface and outer surface, which provides an enhanced appearance of the earth's surface showing a plurality of contoured continents.

Art Unit: 2875

Henning et al. disclose a lamp having a green-emitting phosphor coating (col.1, lines 36-38) on an inner surface.

It would have been obvious to one having ordinary skill in the art, at the time the invention was made to provide the green-emitting phosphor coating of Henning et al. on inner surface of surface feature of Hilderman for decorative light bulb of Lee in order to obtain green color along the inner surface of the contoured continents.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **12, 14-18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henning et al. (US 4,598,229) in view of Hilderman (US 5,030,100).

These references in a combination disclose a structure of decorative bulb but do not disclose a method of manufacturing.

Henning et al. show a bulb whose outer surface is formed into a decorative shape (Fig.1) having an inert gas and phosphor coating. As disclosed in col. 1, lines 36-38, 64-67, the colors can be produced in inert gas (first color) and by presence of phosphor coating (second color); Hilderman discloses (Fig. 4, col.5, lines 26-39) a lighted globe having spherical body and a surface feature [26] mounted on an outer surface of spherical body. The surface feature has an inner surface and outer surface, which provides an enhanced appearance of the earth's surface showing a plurality of

Art Unit: 2875

contoured continents. It is understood, that the bulb may have any desired shape for purpose of aesthetical appearance. Also it is well known in the art and technology that the thickness of the inner surface of the light is thin enough to be invisible from the outside of the bulb.

It would have been obvious to one having ordinary skill in the art, at the time the invention was made to take the steps of structure of decorative light bulb above and provide a method of manufacturing of this bulb.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henning et al. and Hilderman as applied to claim 12 above, and further in view of Rao (US 6,554,453).

Henning et al. and Hilderman disclose the instant claimed invention except for removable plug.

Rao discloses (claim 1) a bulb having removable plug. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to provide the method of Henning et al. and Hilderman with a step of integrating removable plug with respect to a base as taught by Rao for purpose interchangeably removing the bulb.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Tsidulko whose telephone number is (703)308-1326. The examiner can normally be reached on 8 - 5.

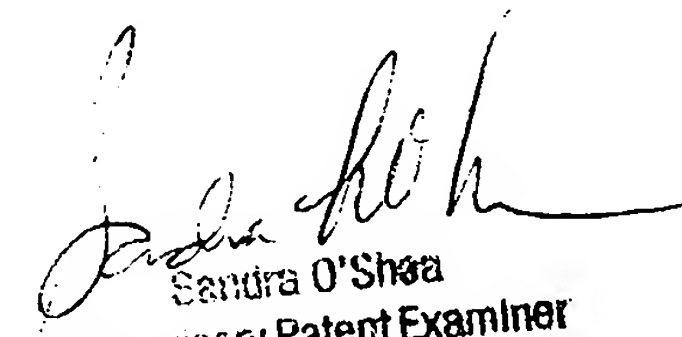
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where

Art Unit: 2875

this application or proceeding is assigned are (703) 872-9318 for regular communications and (703)872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

M.T.
July 17, 2003


Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800